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CBS

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/370,417 08/09/99 BERG

J 8942.30US01

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PM82/1023

EXAMINER

KIM, H

ART UNIT

PAPER NUMBER

3629

DATE MAILED:

10/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/370,417

Applicant(s)
Berg et al.

Examiner
Harry C. Kim

Group Art Unit
3629



☒ Responsive to communication(s) filed on Aug 15, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 18-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 18-27 is/are allowed.

☒ Claim(s) 28-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28 and 30-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wong. Wong discloses all of the claimed structural limitations of an integral plastic retainer clip 12 comprising a first portion 18, a second portion 20 hingedly attached to the first portion 18 at one end 22 and selectively engageable to the first portion 18 at the other end 50, a first retaining area 28, a second retaining area 30, a finger member 40, and a notch 42 for receiving the finger member 40 for separating the first and second retaining areas.

Claims 28 and 30-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Guido et al. Guido et al. discloses all of the claimed structural limitations of an integral plastic retainer clip 1 (Figs. 1-3) comprising a first portion 6, a second portion 5 hingedly attached to the first portion at one end 8 and selectively engageable to the first portion at the other end, a first retaining area 3, a second retaining area 4, a finger member 12, and a notch 14 for receiving the finger member 12 for separating the first and second retaining areas.

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Applicant is reminded that the limitation of the retainer clip being used for retaining the fence strand members in the retaining areas is deemed intended use and thus, cannot be given patentable weight since the claims are directed only to the retainer clip and not in combination with the fence strand members.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong in view of Matsui. Wong, discussed above, shows both of the first and second retaining areas having circular loops rather than the first area having the circular loop and the second area having a rectangular area as claimed. Matsui teaches an integral plastic retainer clip (Fig. 2) comprising a first portion 16 and a second portion 14 hingedly attached to the first portion at one end and selectively engageable to the first portion at the other end to define a circular loop retaining area for clamping a circular element therein. Further, Matsui also teaches that the retaining area may be in the form of a rectangular area (Fig. 16) for clamping a flat elements therein. Therefore, as taught by Matsui, it would have been well within the purview and obvious to one of ordinary skill in the art at the time

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the invention was made to enhance the overall utility and effectiveness of the retainer clip of Wong by modifying the second area to have the rectangular area or any other geometry for accommodating the corresponding shape of the element clamped therein.

Allowable Subject Matter

Claims 18-27 are allowable over the prior art of record.

Response to Arguments

Applicant's arguments filed 8/15/00 have been fully considered but they are not deemed to be persuasive.

Applicant argues that the applied references are directed to a field of endeavor that is completely removed from that of a fence strand retainer clip. However, applicant is reminded that the claims define the metes and bounds of the invention. In this particular case, the claims are directed to a retainer clip with the intended use limitation of the clip being for use in retaining fence strand members. As discussed above, since the applied references clearly show all of the claimed structural limitations of the retainer clip, the rejection of the claims as being anticipated by the applied references is deemed to be proper.

Applicant also argues that the preamble of claim 28 reciting that the retainer clip is "for use in retaining fence strand members" and similar limitations in the claims are entitled to at least some considerations. However, a recitation of the intended use of the claimed invention must result in a

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structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Further, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

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period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Harry C. Kim whose telephone number is (703) 308-2248. The examiner can normally be reached on Mon.-Fri. from 6:00 AM to 3:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

HCK
October 20, 2000


HARRY C. KIM
PRIMARY EXAMINER
TECH CENTER 3600